

## C. REMARKS

### ***Status of Claims***

Claims 1-27 are currently pending in the application. Claims 12, 13, 20, and 27 are amended. Claims 28-30 are cancelled.

### ***Entry of Amendment After Final***

#### *Informalities and Canceled Claims*

First, Applicants respectfully request entry of the amendments to claims 13, 20, and 27 and cancellation of claims 28-30 under 37 CFR 1.116(b)(1) and (2), which allows that “an amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office Action” or “an amendment presenting rejected claims in better form for consideration on appeal may be admitted” after a final rejection.

As to the informalities in the claims, the Final Office Action points to informalities in claim 27 of including more than one “period” and improper positioning of “;and” in the claim. [Final Office Action, p. 2] Applicants note that claim 27 is amended to replace the first period with “;and” and to cancel the first “and” in the claim. Applicants respectfully request entry of the amendments to correct informalities in the claims. By correcting the informalities in claim 27, Applicants comply with the Examiner’s requirement of form set forth in the Office Action.

In addition, as to presenting rejected claims in better form for allowance or consideration on appeal, Applicants note that claims 13 and 20 are not objected to by the Examiner but the form of these claims is amended to present the claims in better form. In particular, Applicants note that “means for” is added to the last two elements of each of claims 13 and 20 to present the elements of the claims in a form consistent with the other elements of claims 13 and 20. Therefore, by correcting the informality in claims 13 and 20, Applicants present the claims in better form for consideration on appeal, and foremost, present the claims in better form for allowance.

As to the canceled claims, Applicants cancel claims 28-30 to place the application in condition for allowance. In particular, as will be further noted with respect

to overcoming the rejections under 35 USC 101 and 35 USC 103(a), claims 1-27 are presented in this final office action in a condition for allowance and claims 28-30 are canceled so that only allowable claims remain pending in the application.

*Overcoming 35 USC 101*

Second, Applicants respectfully request entry of the amendment to claim 12 under 37 CFR 1.116(b)(3), which allows that “an amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented” after a final rejection. In particular, as to claims 12-18, the Final Office Action rejects claims 12-18 as not limited to tangible embodiments. In particular, the Final Office Action states that

“in view of Applicant’s disclosure, specification page 14, lines 25-26, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g. a floppy disk, hard disc) and intangible embodiments (e.g. a carrier wave). As such the claim is not limited to statutory subject matter and is therefore non-statutory. To overcome this type of 101 rejection, the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media.” [Final Office Action, pp. 2-3]

The rejection under 35 USC 101 in the previous Office Action, while rejecting claim 12 as not limited to statutory subject matter, made a suggestion for compliance with 35 USC 101 based on MPEP 2106. In addition, during an Interview with the Examiner, the Examiner cited Interim Guidelines as providing the basis for the rejection under 35 USC 101. [Applicants’ Response, 12-20-2005, p. 14] In Applicants’ previous response, Applicants noted that the Interim Guidelines provided guidance for the Examiner, but at the same time, public comment was open for evaluation of the question of whether a signal encoded with functional descriptive material is similar to a computer readable memory encoded with functional descriptive material. [Applicants’ Response, 12-20-2005, pp. 17, 18] Since September 20, 2005 when the first Office Action was mailed in the present application, the Guidelines for evaluating whether computer program product claims teach statutory subject matter under 35 USC 101 have changed multiple

times and continue to change. As one example of this constant changing, Applicants note that in the Final Office Action, the Examiner did not provide a suggested amendment to overcome the rejection under 35 USC 101 that was provided in the first Office Action. Therefore, in the previous response, Applicants traversed the rejection of claim 12 under 35 USC 101, rather than amending the claims, because the guidelines were still up for review and Applicants requested to receive a rejection based on adopted rules. Applicants respectfully assert that traversing a rejection, where the rejection was based on guidelines still up for public comments, is a good and sufficient reason for not previously amending a claim to overcome a rejection and therefore is a good and sufficient reason why claim 12 was not previously amended to overcome the rejection under 35 USC 101.

Since the purpose of this amendment after final is to place the claims in a condition for allowance, Applicants amend the preamble of claim 12 to limit claim 12 and therefore to also limit dependent claims 13-18, to statutory subject matter as applied in the current guidelines, in view of the specification of the present application. In particular, Applicants amend claim 12 to limit the computer readable media to nonvolatile or volatile media. Applicants respectfully note that paragraph 0037 of the specification of the present invention distinguishes nonvolatile and volatile computer readable media, which are tangible embodiments including floppy disk, RAM or other physical mediums, from transmission media, which can take the form of a carrier wave. Because claim 12 is now limited to include only physical, nonvolatile or volatile computer readable media, claim 12 is limited to statutory subject matter and therefore claims 12-18 are amended to place the application in a condition for allowance.

#### *Overcoming 35 USC 103(a)*

Third, Applicants respectfully request entry of evidence to overcome the rejection under 35 USC 103(a) and therefore place the application in condition for allowance. In particular, Applicants request entry of the declaration after final rejection under 37 CFR 1.116(e), which allows that “an affidavit or other evidence submitted after a final rejection or other final action in an application... but before or on the same date of filing

of an appeal, may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented."

In particular, independent claims 1, 12, 19, 26, and 27 are rejected under 35 USC 103(a) as being obvious over Huat (US Publication 2002/0133565) in view of Beranek (US Patent 6,886,013). The Final Office Action notes that Beranek

"has a common assignee with the instant application. Based on the earlier effective US filing date of the reference, it constitutes prior art only under 35 USC 102(e).... This rejection might also be overcome by showing that the reference is disqualified under 35 USC 103(c) as prior art in a rejection under 35 USC 103(a). See MPEP 706.02(l)(1) and 706.02(l)(2)." [Final Office Action, pp. 3-4]

In following the requirements for disqualifying a reference as prior art in a rejection under 35 USC 103(a), under MPEP 706.02(l)(2), Applicants submit the statement in this paper, clearly and conspicuously marked in a separately labeled section as "EVIDENCE OF COMMON OWNERSHIP TO DISQUALIFY REFERENCE", below. Applicants note that of this statement, MPEP 706.02(l)(2) states that an attorney of record for the present application making the statement is alone sufficient evidence to disqualify commonly owned patent Beranek from being used in a rejection under 35 USC 103(a) against the claims of the present application.

Therefore, because Beranek is disqualified as prior art in the rejection of claims 1, 12, 19, 26, and 27 under 103(c), the rejection of claims 1, 12, 19, 26, and 27 under 35 USC 103(a) should be withdrawn and the claims allowed. In addition, claims 2-11, 13-18, and 20-25, as dependent claims of allowable independent claims 1, 12, and 19, should be allowed.

As to entry of the evidence of common ownership to disqualify the Beranek reference, Applicants note that Beranek is first cited in the Examiner's citation of prior art with the Final Office Action. Applicants respectfully request entry of this evidence of common ownership after final because it was not previously required until the final office action.

***EVIDENCE OF COMMON OWNERSHIP TO DISQUALIFY REFERENCE***

Application 10/042,491 and Patent 6,886,013 were, at the time the invention of Application 10/042,491 was made, owned by International Business Machines Corporation.

***Conclusion***

In view of the amendments to the claims to overcome objections and 35 USC 101, in view of the evidence presented to disqualify Beranek under 35 USC 103(c) and therefore to overcome the rejection of claims 1-27 under 35 USC 103(a), and in view of the cancellation of claims 28-30, pending claims 1-27 are submitted in condition for allowance. Therefore, in view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. *In particular, Applicants respectfully request an opportunity to discuss an Examiner's Amendment to claim 12 should the guidelines, at the time the Examiner considers the amendment, require an amendment different than the currently amendment to claim 12.*

Respectfully submitted,

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